

**REMARKS**

Claims 1-20 are all the claims pending in the application.

Claims 1-3, 6, 7, 17-20 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kim (U.S. patent application publication US 2002/0177067).

Applicants submit that this rejection should be withdrawn because Kim does not disclose or render obvious the positive photoresist composition of the present claims.

As recited in present claim 1, the present invention relates to a positive resist composition that includes:

- (A) a fluorine group-containing resin having a structure wherein at least one of the main chain and the side chain of the polymer skeleton has at least one fluorine atom and a group capable of decomposing under the action of an acid to increase the solubility in an alkali developer;
- (B) a compound capable of generating an acid upon irradiation with at least one of an actinic ray or radiation; and
- (C) a surfactant containing at least one of a silicon atom and fluorine atom.

Kim, as conceded by the Examiner, does not disclose or suggest element (C) of the present resist composition, that is, a surfactant containing at least one of a silicon or fluorine atom.

In the Action, “official notice” is taken that using silicon- or fluorine- containing surfactants is “well known” in the art of photoresist compositions. It is further stated that their use in a composition does not impart novelty to the composition.

Applicants respectfully disagree with the position stated in the Action and request that art be cited in support of this position if it is maintained. Applicants respectfully submit that it is not appropriate or proper to take “official notice” on this issue. The Office has made no showing that the prior art discloses or suggests the use in combination of elements (A), (B), and (C) of the present invention, and particularly element (C).

In more detail, Applicants submit that a resist composition comprising a fluorine-containing polymer has stricter performance of a coatability and development defect, compared with a conventional resist composition. Applicants’ claimed invention uses a specific polymer containing a fluorine atom and a specific surfactant (a Si and/or fluorine-containing surfactant). Applicants’ claimed invention leads to further improvements of the coatability and development, transparency and contrast of dissolution. Applicants submit that even if a resist composition containing a surfactant and a resin having a different constitution from the present invention is known, there is no disclosure or suggestion that a resist composition, as in Applicants’ claimed invention, will provide unexpectedly superior coatability, transparency and contrast of dissolution. Since Kim does not disclose the resist composition comprising the specific resin and the specific surfactant of Applicants’ claimed invention, Applicants submit that their claimed invention is not obvious over Kim.

Further, even if a *prima facie* case of obviousness could be established based on Kim, which it cannot, Applicants submit herewith a sworn English translation of their priority document to remove Kim as prior art and overcome the rejection.

Kim is available as a reference under 35 U.S.C. § 102(e) as of its filing date of September 6, 2001. Applicants' foreign priority document 2001-202298 has a foreign filing date of July 3, 2001. Enclosed is a sworn English translation of Applicants' priority document 2001-202298. Applicants submit that their priority document 2001-202298 supports claims 1-3, 6, 7 and 17-20 as shown in the following chart:

Claim 1	Support can be found in JP 2001-202298 claim 1 on page 1.
Claim 2	Support can be found in JP 2001-202298 claim 2 on pages 1-2.
Claim 3	Support can be found in JP 2001-202298 claim 3 on pages 3-6.
Claim 6	Support can be found in JP 2001-202298 claim 6 on pages 9-11.
Claim 7	Support can be found in JP 2001-202298 claim 7 on pages 11-15
Claim 17	Support can be found in JP 2001-202298 at the bottom of page 50.
Claim 18	Support can be found in JP 2001-202298 at the top of page 51.
Claim 19	Support can be found in JP 2001-202298 at the middle of page 51.
Claim 20	Support can be found in JP 2001-202298 on pages 26-27.

In view of the above, Applicants respectfully request that the Examiner withdraw the § 103 rejection based on Kim.

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Amendment under 37 C.F.R. § 1.111

Claims 4, 5, and 8-16 have been objected to as being dependent upon a rejected base claim, but are indicated to be drawn to allowable subject matter.

Applicants have submitted a sworn English translation of their priority document 2001-202298 to remove Kim as prior art and overcome the rejection of claims 1-3, 6, 7 and 17-20 based on Kim. Therefore, claims 4, 5, and 8-16 are no longer dependent on rejected base claims. Applicants therefore respectfully request that the Examiner withdraw the objection and allow claims 4, 5, and 8-16.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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Date: January 5, 2004